UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,298	09/08/2000	Kenneth D. Simone JR.	068520.0110	3516

7590 04/07/2004

Baker Botts LLP
2001 Ross Avenue
Dallas, TX 75201-2980

EXAMINER	
PRIETO, BEATRIZ	
ART UNIT	**PAPER NUMBER**
2142	7

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/658,298	Applicant(s) SIMONE, KENNETH D.
	Examiner B. Prieto	Art Unit 2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *three* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 September 2000*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 September 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2, & 4-6*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to application No. 09/658,298 filed 09/08/00, claims 1-10 have been examined as hereby set forth.

2. Claim 1 recites the limitation "said functions definitions" and "said set" in line 8, further "the corresponding function definition" on line 10 and furthermore claim 6 recited "said function portions" on line 6. There is insufficient antecedent basis for this limitation in the claim. Correction is required.

Claim Rejection

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claim 1-2, 4, 6-8 and 10 are rejected under 35 U.S.C. 102(s) as being anticipated by Simpson et. al. U.S. Patent No. 6,021,115 (Simpson hereafter).

Regarding claim 1, Simpson a system/method related to processing and transmitting data, including;

providing a set of predetermined function definitions, which are distinct from one another (see elements 30-42 of Fig. 2);

storing set of instructions comprising a method including a process, operation or task definition or specification ("project definition") including said set of distinct predetermined functions or operations or tasks (col 1/lines 32-46), which include:

a plurality of function portions (30-42) which each correspond to one of said set of predetermined function definition (see Fig. 2),

each of said plurality of function portions define one input port and one output port (30) that are functionally related according to the corresponding function definition (col 1/line 35-57);

output and input ports (30) through which data from a source is supplied from a source and data at a destination is received (col 1/lines 38-57, col 4/lines 55-56, ports configured to supply/receive data see col 15/lines 6-7);

circuitry ("source portion") for identifying a data element or input ("data source") and defining an output port through which data from the data source can be supplied or provided (source portion (circuitry 37) see col 6/lines 60-67, data source see col 6/lines 7-16, col 2/lines 13-15, 55-57 and col 5/lines 30-32),

circuitry ("destination portion") for identifying a data element or output ("data destination") and defining an input port through which data can be supplied to the data destination (designation circuitry see col 2/lines 32-46, 53-55 and input designation see col 3/lines 35-42, destination source see col 6/lines 16-23); and

a table ("binding portion") including information that each associate a respective said input port with one of said output ports (see table 42 of Fig. 2 for determining the route of selected data processed transmitted through the chip comprising a switch having a plurality of ports 30 each providing an output/input link coupled to respective input output/ports col 5/lines 21-40); and

executing said method or process(es) ("project definition") including the step of transmitting data ("a communication") on through a communications link (transmission through a network see col 2/lines 47-49, communication links see col 5/lines 21-28).

Regarding claim 2, carrying out said transmitting step as said executing step is completing, i.e. data has from the data source is available to be supplied to the destination upon the execution of the method (see col 2/lines 47-49, col 5/lines 21-28).

Regarding claim 4, said communications link to include a network (see col 4/lines 26-34).

Regarding apparatus claims 7-8 and 10, specifically the computer readable medium encoded with a computer program which comprising the method discussed on the method claims 1-2 and 4, respectively, said program being operable when executed to perform the functions of said method, same rationale of rejection is applicable.

Regarding claim 6, wherein said transmitting step includes the step of causing one of said function portions to send the communication (see col 2/lines 47-49, col 5/lines 21-28).

5. Claims 3, 5 and 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson in view of Sato et. al. U.S. Patent No. 6,230,186 (Sato hereafter).

Regarding claim 3, however the above-mentioned prior art does not explicitly disclose the use of electronic mail.

Sato teaches a system/method related to the processing of data, including formatting data as an electronic mail, specifically, a set of instruction (e-mail creator program) executed by a processor (CPU 20) for formatting data (e.g. text) as an electronic mail and vice-verse for transmission according to an e-mail protocol (e.g. SMTP) over the Internet by Internet protocols (e.g. TCP/IP) through a network.

It would have been obvious to one ordinary skilled in the art at the time the invention was made given Simpson suggestions for automated processing/transmitting of data between computer in a local area network environment arranged to input and output data in the form of voice, video or computer data in digital form, or any mixture of them, to include Sato's teachings for transmitting data in the e-mail form used typically in local are network environment for supporting communications between computer as noted by Sato, for among other the transmission of image data, motivation would be enable destination the flexibility to process transmitted communication in the text or html format according to destination's capabilities (col 9/lines 46-61).

Regarding claim 5, said network to include a portion of the Internet (Fig. 1 element 12).

Regarding apparatus claim 9, specifically the computer readable medium encoded with a computer program which comprising the method discussed on the method claim 3, said program being operable when executed to perform the functions of said method, same rationale of rejection is applicable.

Double Patenting Rejections

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ormum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1 and 7 of instant application are unpatentable under the judicially created doctrine of "obviousness-type" double patenting with respect to claim 1 of application 09/658,163 issued 02/18/04. Although the conflicting claims are not identical, they are not patentable distinct from each other because claims 1 and 7 of instant application are obvious over patent claim 1 in that patent claim 1contains all the limitations of claims 1 and 7 of instant application. Claims 1 and 7 of instant application therefore is not patently distinct from the earlier patent claim and as such is unpatentable for obvious-type patenting.

8. Claims 1 and 7 of instant application are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. application No. 09/658,163 issued 02/18/04 in view of NetBuilder: an environment for integrating tool and people, Dabke, P. et. al. 1998, pages 465-472.

Dabke et. al. discloses a process (activities) definitions in a distributed network environment, including the integrations of individual diverse tools into programs that define a process, these programs are stored for future user including being invoked and executed supporting difference communication protocols supporting the execution of theses modules (invocation of an module may result in running a program) (components) connected via links (links shown in solid lines on Fig. 1 between different modules connect input and output ports) that support communication between the modules which forward information (e.g. result of the execution of one module to other connected modules) among themselves and enable the execution of components over the network (see page 465-467).

It would have been obvious at the time the invention was made to use the teachings of the patented in combination with Dabke et. al. teachings for storing process definitions representing/defining a plurality of diverse predetermined functions distributed over the network, and transmitting a communication over a communication link. Motivation would be enable the integration of diverse tools (or modules) into executable program that define process, and have those programs for capturing workflow (process) automation executed and store for future use in a distributed environment including heterogeneous computing networks.

9. Claims 1 and 7 of instant application are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,651,121 in view of Dougherty et al. U.S. Patent No. 6,370,575 (hereafter referred to as Dougherty). The conflicting claims represent the same invention and differ by feature(s) that would have been obvious.

10. Regarding claims 1 and 7, the features of these claims are all taught by claim 1 of patent 6,651,121, however the features of transmitting data ("a communication") over a communication link and the executing a "project" process, task or activity definition or specification (e.g. stored

as a file or program or set of instructions) is taught by Dougherty (abstract and column 10, lines 13-19). It would have been obvious to one ordinary skilled in the art at the time the invention was made to include the teachings of Dougherty for supporting the communication between distant organizations as discussed by Dougherty.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure; pertinence is presented in accordance with MPEP§ 707.05. Copies of documents cited will be provided as set forth in MPEP§ 707.05(a):

U.S. 5,974,431: Iida teaches an automated process for reading image data with a file name in a database, superimposing over the image data the file name. The superimpose image data is reformatted in a file stored in a database storage for subsequent access.

U.S. 6,342,954: Hisatomi et. al. teaches reading an image stored as an electronic document file by a processor, including reading the electronic document file name, including converting the file name into a barcode and superimposing the file name in the form of a barcode over the image and storing for subsequent retrieval.

12. Applicant is reminded that in accordance with 37 CFR 1.530 (e) Status of claims and support for claim changes. Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there MUST also be supplied, on pages separate from the pages containing the changes, the status (i.e., pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper (see MPEP 2234).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (703) 305-9705. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to the Central Fax Office:

(703) 872-9306, for Official communications and entry;

Or Telephone:

(703) 306-5631 for TC 2100 Customer Service Office.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Fourth Floor (Receptionist), further ensuring that a receipt is provided stamped "TC 2100".

B. Prieto
TC 2100
Patent Examiner
April 5, 2004